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008/014

DEC 18 2006

PATENT

App. Ser. No.: 10/600,014

Atty. Dkt. No. ROC920030209US1

PS Ref. No.: IBM/K30209

REMARKS

This is intended as a full and complete response to the Final Office Action dated October 18, 2006, having a shortened statutory period for response set to expire on January 18, 2007. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-4, 12-24 and 25-28 are pending in the application. Claims 1-4, 12-24 and 25-28 remain pending following entry of this response. Claims 1, 12 and 18 have been amended. Applicants submit that the amendments and new claims do not introduce new matter.

Interview Summary

On December 18, 2006, a telephonic interview was held between Christopher T. Shannon (Attorney), Shew-Fen Lin (Examiner), and Mohammad Ali (Primary Examiner). The parties discussed the cited references. The parties also discussed proposed amendments to the claims. The proposed amendments to the claims are reflected in this response.

Double Patenting Rejection

Claims 12 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 and 25 of co-pending Application No. 10/600,021.

Applicants have filed a terminal disclaimer to address the Examiner's double patenting rejection. Therefore, Applicants request the rejection be withdrawn.

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PS Ref. No.: IBM/K30209Claim Rejections - 35 U.S.C. § 102

Claims 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by *Gupta et al.* (US Patent 6,956,593 (hereinafter, "*Gupta*")).

Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, Gupta does not disclose "each and every element as set forth in the claim." For example, Gupta does not disclose "a set of annotation structures, each annotation structure defining one or more annotation fields." Gupta is directed to a graphical user interface for creating, viewing and temporally positioning annotations for media files (see, for example, the Abstract). In Gupta, the interface allows a user to select a temporal point within a media file to create an annotation and allows a user to select the type of annotation to be created (e.g., text annotation or URL annotation). (Gupta, Column 2, lines 23-27 & Column 13, lines 25-32). However, nowhere in Gupta is a set of annotation structures defining one or more annotation fields disclosed, as recited in the claims.

Therefore, Applicants submit that independent claims 12 and 18, as well as their dependent claims, are allowable and withdrawal of the rejections is respectfully requested.

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PS Ref. No.: IBM/K30209Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 21-24, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Altman* (US Pub 2004/0163042) in view of ESP (Electrical Schematics Page, April 25, 2002, <http://www.jlab.org/accel/inLgroup/electr.htm>).

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third limitation.

Specifically, the prior art reference (or references when combined) fails to teach or suggest at least the claim 1 and claim 21 limitation of "a set of annotation structures, each defining a set of annotation fields." The Examiner argues that *Altman* discloses "a set of annotation structures, each defining a set of annotation fields" at Figure 13A and paragraph [0043]. However, Applicants submit that the cited figure, the cited section, and *Altman* as a whole, do not teach a set of annotations structures.

The cited figure (Figure 13A) merely illustrates an exemplary interface for "creating a review of a document." (*Altman*, Paragraph [0058]). The interface includes fields for specifying a file name of the document to be reviewed, and other fields related to reviewing a document. The cited section (*Altman*, Paragraph [0043]) describes Figure 6 which illustrates results of a database query. (*Altman*, Paragraph [0042]). The results of the database query are four records, each record containing four fields including, for example, the x and y locations of an annotations within a document. (*Altman*, Paragraph [0042]). Paragraph [0043] discusses how one of the database

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record fields may be used to indicate a URL for the annotation. The URL may be used to indicate a location of a graphic to be displayed at the location of the annotation (Altman, Paragraph [0042]). The graphic may be displayed at the x and y location of an annotation and be used to display the text of the annotation when selected ("clicked on") by a user. However, this section of Gupta cited by the Examiner does not teach a "set of annotation structures, each defining a set of annotation fields" as recited in the claims, rather it describes a series of annotations returned from a database query. Furthermore, nowhere else in Altman is "a set of annotation structures" disclosed.

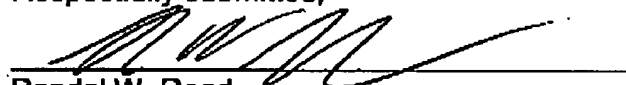
Therefore, Applicants submit that independent claims 1 and 21, as well as their respective dependent claims, are allowable and withdrawal of the rejections is respectfully requested.

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PS Ref. No.: IBM/K30209**Conclusion**

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted,


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